

Appl. No. 10/802,156  
Amdt. Dated October 30, 2008  
Reply to Office Action of June 30, 2008

### **REMARKS**

Claims 1 and 3 – 7 are currently pending and at issue in the present application. All claims stand rejected. Applicant respectfully requests reconsideration of all claims in light of the above amendments and the remarks set forth below.

#### **Claim amendments**

Claim 1 has been substantially amended to more accurately reflect the invention of the present application.

The preamble of the claim has been amended to recite the invention as a holder for securing a flexible bag within a trash container. This amendment is supported by the several drawing figures and the specification, specifically the “Detailed Discussion” beginning on page 3. Terminology in the preamble which limits the structure of the claimed invention must be treated as a claim limitation (See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989). Applicants contend that the added language is both structural and limiting of the scope of the invention.

The body of Claim 1 was also amended to better characterize the invention. For example, the limitation “surface integral to and projecting from the sidewall” has been amended to add the term “bag-retaining” before “surface” and the limitation “in a rearward direction opposite the bag-receiving area” to better describe the relationship between the surface and the bag-retaining area. This language is supported by the drawings of FIGURES 1 – 5, which clearly shows the top wall 31 projecting outside the rim 13 of the container. Also, the last paragraph of page 4 states that “a flat top wall 31 . . . projecting rearwardly from the peripheral sidewall 11 . . .”

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Further, the recess of the holder has been amended to limit the positioning of the recess to be outside the bag-receiving area on the surface. This amendment is also supported by the drawing FIGURES 1 – 5 and specifically page 5, lines 2 – 3 which states “just rearwardly of the peripheral sidewall 11 is a rectangular recess 34. . .”

**Sections 102(b) and (e) Rejections**

The Examiner has rejected Claims 1 and 3 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 4,747,511 to Dutt et al. (hereafter “Dutt”). Applicant respectfully disagrees with this rejection and requests reconsideration.

Dutt is directed to a plug-type opener for plastic can ends, particularly beverage containers. Dutt in no way discloses a holder for a flexible bag within a trash container. Dutt does not disclose a rim at an upper end of the sidewall (18) over which a flexible bag is secured. Dutt does not disclose a bag-retaining surface (indented upper surface having opening 90) integral to the sidewall. Further, the surface of Dutt asserted by the Examiner does not extend rearwardly of the sidewall outside the bag-retaining area.

Dutt fails to teach not just one, but several elements of the claimed invention. Accordingly, Dutt cannot be considered to anticipate the invention under 102(b). Reconsideration is respectfully requested.

The Examiner has also rejected Claim 1 under 35 U.S.C. 102(e) as anticipated by U.S. PreGrant Publication No. 2004/0045964 to Alvares et al. (hereafter “Alvares”). Applicant respectfully disagrees with this rejection and requests reconsideration.

Alvares is directed to a can for paint white base. Alvares in no way discloses a holder for a flexible bag within a trash container. Alvares does not disclose a rim at an upper end of the

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sidewall (18) over which a flexible bag is secured. Dutt does not disclose a bag-retaining surface (the horizontal planar surface between reference sign 13 and opening 12) integral to the sidewall. Further, the surface of Alvares asserted by the Examiner does not extend rearwardly of the sidewall outside the bag-retaining area.

Alvares fails to teach not just one, but several elements of the claimed invention. Accordingly, Alvares cannot be considered to anticipate the invention of Claim 1 under section 102(e). Reconsideration is respectfully requested.

#### Section 103(a) Rejection

The Examiner has also rejected Claims 1 and 3 – 7 under 34 U.S.C. 103(a) as obvious over U.S. Patent No. 5,119,957 to Joyce-Middaugh (hereafter “Joyce-Middaugh) in view of U.S. Patent Nos. 5,836,553 to Bergaila (“Bergaila”) and 5,476,187 to Marisco (“Marisco”).

Applicants respectfully traverse this rejection and request reconsideration.

The Examiner concedes that Joyce-Middaugh does not disclose a bag-retaining notch. However, Applicants contend that Joyce-Middaugh also fails to disclose a rim at an upper end of the sidewall (11) over which a flexible bag is secured. Dutt does not disclose a bag-retaining surface (top surface of flange 31) integral to the sidewall. Further, as required by amended Claim 1, the surface of Joyce-Middaugh asserted by the Examiner does not extend rearwardly of the sidewall outside the bag-retaining area.

Likewise, Bergaila and Marisco do not disclose these missing features either. Accordingly, even taken in combination, Joyce-Middaugh, Bergaila and Marisco fail to render obvious the elements of amended Claim 1.

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As amended Claim 1 is now believed to be in condition for allowance in view of the cited art, Applicant contends that remaining Claims 3 – 7 are also in condition for allowance. Such remaining claims depend directly from Claim 1, merely adding further limitations to the base claim. Accordingly, all claims are considered to be in condition for allowance and reconsideration is respectfully requested.

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### CONCLUSION

Claims 1 and 3 – 7 are currently pending and at issue in the present application. Claim 1 has been amended to more accurately claim the invention of the present application. No new matter has been added and all claims are considered to now be in condition for allowance.

Should any formalities remain which may be addressed by Examiner amendments, the Examiner is requested to contact by phone the undersigned attorney to expedite the prosecution of the present application.

Respectfully submitted,

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